

REMARKS

Claims 1-21 are pending in this application. Claims 1 and 11 have been amended to recite “diffusion coefficient” instead of “property” and to add that “the gas in the first and second chambers has a substantially equal pressure.” Support for this amendment can be found, for example, in ¶¶ 10, 18 and 20 of the specification. No new matter is added by this amendment.

Claims 1-4, 8-15 and 18-21 have been rejected under 35 U.S.C. § 102 as anticipated by, or in the alternative under 35 U.S.C. § 103 as obvious over, Drake et al. “On a Cell to Measure Diffusion Coefficients of Gases Through Cigarette Papers,” Int. J. Heat Mass Transfer, 23:127-134 (1980) (“Drake”). Additionally, Claims 1-21 have been rejected as obvious over the combination of Drake and WO 03/019132 (“Cholet”).

35 U.S.C. § 103

Taking the later rejection first: at the threshold, in order to establish a *prima facie* case of obviousness, the Examiner must provide a showing that, *inter alia*, the cited prior art reference or combination of references teaches or suggests all of the claim limitations. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991); MPEP 2142 and 2143. Applicants respectfully assert that the cited reference (Drake) does not teach or suggest all of the claim limitations. Therefore, applicants respectfully traverse the 103 rejections over Drake alone or in combination with Cholet.

Claims 1-4, 8-15 and 18-21 - § 103 Rejection over Drake

Amended independent claim 1 reads as follows:

An apparatus adapted to measure a property of a cigarette paper wrapper, said apparatus comprising: a sampling device defining a first chamber portion and a corresponding second chamber portion, the first and second chamber portions engaging at and defining a

sampling area, the sampling device being configured to receive the cigarette paper wrapper such that the cigarette paper wrapper spans the sampling area and separates the first chamber portion from the second chamber portion; a first gas source configured to supply a regulated flow of a carrier gas to the first chamber portion; a second gas source configured to supply a regulated flow of a detectable gas to the second chamber portion; and an analyzer device in communication with the first chamber portion and configured to receive a resultant gas flow, the resultant gas flow including the carrier gas and any of the detectable gas entering the first chamber portion through the cigarette paper wrapper, the analyzer device being further configured to be capable of determining an amount of the detectable gas in the resultant gas flow so as to thereby determine a property diffusion coefficient of the cigarette paper wrapper wherein the gas in the first and second chambers has a substantially equal pressure.

Amended independent claim 11 reads as follows

A method of measuring a property of a cigarette paper wrapper, said method comprising: receiving a cigarette paper wrapper in a sampling device defining a first chamber portion and a corresponding second chamber portion, the first and second chamber portions engaging at and defining a sampling area, the sampling device being configured to receive the cigarette paper wrapper such that the cigarette paper wrapper spans the sampling area and separates the first chamber portion from the second chamber portion; supplying a regulated flow of a carrier gas to the first chamber portion; supplying a regulated flow of a detectable gas to the second chamber portion; receiving a resultant gas flow at an analyzer device in communication with the first chamber portion, the resultant gas flow including the carrier gas and any of the detectable gas entering the first chamber portion through the cigarette paper wrapper; and determining, with the analyzer device, an amount of the detectable gas in the resultant gas flow so as to thereby determine a property diffusion coefficient of the cigarette paper wrapper wherein the gas in the first and second chambers has a substantially equal pressure.

The Examiner admits that Drake fails to describe “configuring the analyzer to determine the diffusion coefficient of the paper with respect to the detectable gas.” Furthermore, the Examiner fails to contend that Drake would have motivated by (implication or otherwise) the inclusion of such element. It follows that, for at least this reason, Drake does not teach or

suggest all of the limitations of independent claims 1 or 11. Thus, claims 1 and 11 would not have been obvious over Drake. Applicants note that claims 2-4, 8-15 and 18-21 depend, directly or indirectly, from either independent claim 1 or 11 and thus would not have been obvious over Drake for the same reasons.

Claims 1-21 - § 103 Rejection over Drake and Cholet

As described above, the Examiner admits that Drake fails to describe “configuring the analyzer to determine the diffusion coefficient of the paper with respect to the detectable gas.” The Examiner, however alleges that Cholet supplies the missing analyzer and that it would have been obvious to combine the teachings of Drake and Cholet to “automate diffusion measurements.” Applicants urge that the apparatus of Cholet merely describes a device for measuring permeability by using a *pressure differential between two chambers*. See Cholet at ¶¶ 1, 3 and 10. Therefore, Cholet could not have provided a teaching of the analyzer for determining the diffusion coefficient which the Examiner admits is missing from Drake, and the combination of Drake and Cholet would not have made obvious all of the claim limitations.

35 U.S.C. § 102

The rejection also alleges that Drake anticipates claims 1-4, 8-15 and 18-21.

In order for a reference to anticipate a claim, it must disclose each and every limitation of the claim. See MPEP 2131. Applicants respectfully maintain that Drake does not disclose each and every limitation of each of claims 1-4, 8-15 and 18-21. Applicants therefore traverse the 102(b) rejection.

As described above, the Examiner admits that Drake fails to describe “configuring the analyzer to determine the diffusion coefficient of the paper with respect to the detectable gas.” Therefore, for at least this reason, Drake cannot anticipate independent claims 1 or 11.

Applicants note that claims 2-4, 8-15 and 18-21 depend, directly or indirectly, from either independent claim 1 or 11 and thus are not anticipated for the same reasons.

Therefore, for the above reasons, the claims 1-4, 8-15 and 18-21 are not untenantable for anticipation or obviousness in view of Drake, and claims 1-21 are not untenantable for obviousness over the combination of Drake and Cholet.

The claims are submitted to be in condition for allowance, and the speedy issuance of a Notice of Allowability is requested.

* * *

If a telephone interview would be of assistance in the prosecution of this application, the Examiner is invited to telephone Applicants' undersigned attorneys at his convenience at the number provided below.

No fees, except the fees for a one month extension of time, are believed due in connection with the filing of this *Amendment and Response*. However, the Director is hereby authorized to charge any required fees and credit any overpayments to Deposit Account No. 50-0540.

Respectfully submitted,

Dated: December 18, 2006

By: /Henry J. Cittone/

Henry J. Cittone, Reg. No. 57,206
George B. Snyder, Reg. No. 27,675
Attorney for Applicants
KRAMER LEVIN NAFTALIS & FRANKEL LLP
1177 Avenue of the Americas
New York, New York 10036
(212) 715-9100 (phone)
(212) 715-8000 (fax)